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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4013-00100

CERTIFICATE OF FILING

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Katherine Yee

Katherine Yee

Application Number

09/747,909

Filed

December 22, 2000

First Named Inventor

Lucy Broyles

Art Unit

3726

Examiner

GATES, Eric Andrew

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/98)

☒ attorney or agent of record.
Registration number 47,412
☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Shannon W. Bates

Signature

Shannon W. Bates

Typed or printed name

972-731-2288

Telephone number

October 20, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW

Claims 17-19, 23-26, 28, 30, 31, 33-36 and 38-42 are currently pending in the application and are listed on pages 2-8 of the Response to Office Action filed by Applicant on May 12, 2008. In the *Final Office Action* dated August 20, 2008, the rejection of claims 17-19, 23-26, 31, 33-36 and 40-42 was maintained under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,844,797 to *Johnson* in view of U.S. Patent No. 5,957,693 to *Panec* and in view of excerpts from non-patent reference Guiding the Reading Process by Booth. The rejection of claims 28, 30, 38 and 39 was also maintained under 35 U.S.C. §103(a) as being unpatentable over *Johnson* in view of *Panec* and Booth and further in view of U.S. Patent No. 5,651,678 to *Phillips*.

I. Improper Rejection – No Prima Facie Case of Obviousness

Applicant respectfully traverses these rejections and submits that no *prima facie* case of obviousness has been established as to the pending claims at least because: (1) there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine *Johnson* with *Panec*, Booth and/or *Phillips*; and (2) the references fail to teach or suggest all of the claimed limitations.

Johnson is directed to a photograph album for a selected theme comprising pre-printed pictures or views and accompanying text “to provide the user with guidance and inspiration to take a corresponding series of photographs on the same theme” (Abstract). The user’s photographs are substituted for the pre-printed pictures or views to provide “a structured album of photographs and appropriate accompanying text” (Abstract). In one embodiment, the photograph album is in the form of a guidebook, with spaces to receive photographs taken by the user. The stated purpose is to “provide a personalized yet organized record of the visit” while providing “additional interest for third parties viewing the album in the way that a disorganized collection of individual photographs will not” (col. 1, lines 13-26). Thus, *Johnson* is directed only to a method of creating structured, organized and personalized photograph albums for a selected theme, which has nothing whatsoever to do with teaching a pre-reader to read according to the claimed invention.

Panec is directed to a method for promoting reading in a novice reader using a book that includes a story with two texts, one written at a reading level appropriate for a skilled reader and the other written at a lower reading level appropriate for the novice reader. Thus, the method

disclosed by *Panec* promotes reading by using a traditional, pre-assembled, non-personalized book.

Phillips teaches an educational aid and a method for using the system to teach students to read using sight-word vocabularies. The method relies on the student's natural ability to recall information, such as simple songs, rhymes, and stories which are easily memorized (col. 5, lines 53-55). Thus, the method disclosed by *Phillips* promotes sight-word reading based on memorization.

The excerpts from Booth provided by the Patent Office describe a cueing system that readers rely upon for reading comprehension. The cueing system is said to comprise pragmatic and semantic cues that help readers anticipate the meaning of text, syntactic cues that help readers use syntax and language patterns to predict words and phrases, and phonics cues that help readers test predictions for unrecognized or confusing words so as to construct or confirm meaning (see Booth, page 8, "The Cueing Systems").

For syntactic cueing, the author states that "[a] reader must be able to attach meaning to the words, to have some pre-existing knowledge of how this new textual information is integrated into their existing knowledge and experience base." Thus, the author advocates helping readers develop their semantic cueing systems by "supplying them with print resources that tap into their worlds." The author also advocates increasing the child's knowledge base through a variety of different classroom exercises, such as participating in discussions before and after reading, making a story map, creating a character sketch, defining the writer's style and identifying the mood. The classroom exercises may be supplemented by field trips, films and newspapers (see Booth, page 8, "Semantic Cues (Knowing About the World)"). The author states that "[i]f the children can't connect the reading to personal aspects of the[i]r lives, their level of reading comprehension will suffer" (see Booth, page 11, "Meaning and Experience").

Thus, the methods disclosed by Booth promote increasing the reading comprehension of student readers by using traditional, pre-assembled, non-personalized books that relate to their existing knowledge base. Booth also discloses increasing the reader's knowledge base by various means. However, Booth has nothing to do with methods for teaching a pre-reader how to read according to the claimed invention. Indeed, Applicant submits that the methods advocated by Booth would only be used effectively after the pre-reader has already learned how to read.

A. There is No Motivation to Combine the Cited References

Applicant respectfully submits that there is no suggestion or motivation to modify *Johnson*, or to combine *Johnson* with *Panec*, Booth and/or *Phillips*, either within the references themselves, or in the knowledge generally available to one of ordinary skill in the art. *Johnson* is focused only on methods for creating photograph albums. Such methods clearly have nothing to do with teaching a pre-reader to read. *Johnson* makes no suggestion whatsoever that its method for creating a photograph album could be used for such purposes. Moreover, one of ordinary skill in the art of teaching someone to read according to *Panec* or *Phillips*, or improving reading comprehension according to Booth, would not be motivated to look to the art of photograph albums for guidance. In fact, modifying the *Johnson* photograph album to include repetitive text as suggested by the Patent Office would detract from the interest that adults would have in viewing the album, which seems inconsistent with the purposes set out in the *Johnson* reference.

Moreover, there is no suggestion or motivation to combine Booth with *Johnson*, *Panec* and/or *Phillips*. In particular, the methods of enhancing reading comprehension according to Booth would only be applied after the pre-reader learns to read. Therefore, if the photograph album of *Johnson* was modified to include the repetitive text of *Panec* or the sight words of *Phillips*, such an album would be too elementary to improve the reading comprehension level of a reader according to the methods of Booth. As such, Applicant submits that neither the references themselves, nor the knowledge generally available to one of ordinary skill in the art would suggest or provide motivation to combine elements of methods for constructing photograph albums as disclosed by *Johnson* with elements of methods for teaching a pre-reader to read as disclosed by *Panec* and *Phillips* and/or with elements of methods for improving the reading comprehension levels of readers according to Booth.

B. The Cited References Fail to Teach or Suggest All of the Claim Limitations

In *KSR Int'l Co. v. Teleflex, Inc.*, the United States Supreme Court noted that, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art,” but, additionally whether “the claim extends to what is obvious.” See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741-42 (2007). Expounding on its edict, the Supreme Court went on to opine that an obviousness determination is based upon a “proper application of *Graham*,” including consideration of “secondary factors” that may weigh against an obviousness determination. See *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.

Ct. at 1745 (citing *Graham v. John Deere Co. of Kansas City, et al.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966)). The “proper application of *Graham*” begins with a determination of whether the cited prior art contains all the elements of the contested claims. See *Graham v. John Deere Co. of Kansas City*, 383 U.S. at 22 (an obviousness determination begins with a finding that “the prior art as a whole in one form or another contains all” the elements of the claimed invention.).

Applicant respectfully submits that the combination of *Johnson* with *Panec*, *Booth* and/or *Phillips* fails to establish a *prima facie* case of obviousness as to any of the pending claims at least because none of the cited references, either alone or in combination, teaches or fairly suggests all of the claimed limitations. In particular, with respect to independent claims 17, 31 and 42, the cited references fail to teach or fairly suggest a process comprising: obtaining a repetitive language kit having a theme related to a planned shared experience between a reader and a pre-reader, the reader sharing an actual experience with the pre-reader corresponding to the planned shared experience, memorializing the actual shared experience between the reader and the pre-reader through one or more pictorial representations, constructing a personalized repetitive language book including said pictorial representations, and the reader reading a plurality of pages of said book to the pre-reader.

Instead, the *Johnson* reference discloses a method whereby a user obtains a photograph album with a theme, the user has an actual experience related to the theme, the user memorializes the actual experience with photographs, and the user later shares the assembled photograph album with a third party. Thus, the planned experience (the outing) that relates to the theme of the photograph album is actually experienced and memorialized by the user without the third party. The shared experience between the user and the third party (reviewing the photo album) is unrelated to the photograph album theme. Thus, *Johnson* fails to teach or suggest the claimed “planned shared experience” between a user (such as a reader) and a third party (such as a pre-reader) related to the theme of a repetitive language kit; the claimed “actual shared experience” between the user and the third party corresponding to the planned shared experience; and the claimed reader reading a plurality of pages of the book to the pre-reader.

Panec, *Booth* and *Phillips* all fail to make up for this lack of teaching by *Johnson*. Instead, neither *Panec* nor *Phillips* teach or suggest that their methods and materials used for teaching a person to read have anything whatsoever to do with a planned shared experience between the reader and the pre-reader related to a theme of the materials, the reader sharing an

actual experience with the pre-reader corresponding to the planned shared experience, or memorializing the actual shared experience between the reader and the pre-reader.

Likewise, Booth fails to teach or suggest obtaining a kit having a theme related to a planned shared experience between a reader and a pre-reader, the reader sharing an actual experience with the pre-reader corresponding to the planned shared experience, memorializing the actual shared experience between the reader and the pre-reader through one or more pictorial representations, constructing a book including said pictorial representations, or the reader reading a plurality of pages of said book to the pre-reader. Indeed, Booth is directed to methods that involve two readers – a teacher reader and a student reader – rather than a reader and a pre-reader. Moreover, there is no disclosure of the two readers memorializing an actual shared experience corresponding to a planned shared experience related to the theme of a book that the two readers construct, or one reader reading the pages of any book to the other reader.

II. Preservation of Additional Grounds for Appeal

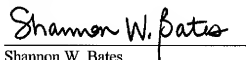
In an effort to simplify the issues for consideration by the panel, Applicant has focused this discussion on the scope of the independent claims. However, Applicant reserves the right to pursue additional grounds for appeal should the panel elect to uphold the rejections.

III. Summary

Applicant submits that the grounds for rejection are improper at least because there is no motivation to combine the cited references, and the cited references fail to teach or suggest the claimed limitations. Consequently, the references fail to render the pending claims obvious as required by 35 USC § 103(a). Accordingly, Applicant respectfully requests that the rejections be withdrawn and the pending claims be allowed.

Respectfully submitted,

CONLEY ROSE, P.C.



Shannon W. Bates

Reg. No. 47,412

ATTORNEY FOR APPLICANTS

Date: October 20, 2008

5601 Granite Parkway, Suite 750

Plano, Texas 75024

Telephone: (972) 731-2280

Facsimile: (972) 731-2289